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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|------------------------|------------------|
| 10/803,506 | 03/17/2004 | Masahito Uchikoshi | 09799107-0019 | 5709 |
| 26263 | 7590 | 08/31/2006 | EXAMINER | |
| SONNENSCHN NATH & ROSENTHAL LLP | | | WYSZOMIERSKI, GEORGE P | |
| P.O. BOX 061080 | | | ART UNIT | |
| WACKER DRIVE STATION, SEARS TOWER | | | PAPER NUMBER | |
| CHICAGO, IL 60606-1080 | | | 1742 | |

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,506

Applicant(s)

UCHIKOSHI ET AL.

Examiner

George P. Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,4 and 8 is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/966861.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 6, 7, and 9 are objected to because of the following minor informalities:

a) In the last line of claim 6, it appears that "impurity copper" should be changed to read --monovalent copper ions--.

b) In claim 7, line 4, it appears that "impurity copper are" should be changed to read --impure copper is--.

c) In claim 9, line 7, "the" (second occurrence) should read --an--.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Yoshizawa et al. (U.S. Patent 4,526,611).

Yoshizawa discloses heating cobalt chloride (Yoshizawa claim 3) in hydrogen (claim 5) at a temperature of 600.deg.C or 873K (claim 14) to obtain cobalt metal. Thus, all aspects of the claimed invention are held to be fully disclosed by Yoshizawa et al.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shindo et al. (U.S. patent 5,667,665).

Shindo columns 4-5 discloses contacting a crude cobalt material with an aqueous solution of cobalt chloride having a hydrochloric acid concentration of 7N to 12N, contacting this solution with an anion exchange resin to adsorb cobalt and remove at least one impurity as recited in instant claim 9, and eluting cobalt while removing at least one impurity as recited in instant claim 10 by using a hydrochloric acid solution with a concentration of preferably 3N to 4N. Shindo does not specify "injecting an inert gas into an aqueous solution of cobalt chloride" as required by the instant claims. However, one of ordinary skill in the art would want to employ an inert gas in the prior art process in order to avoid any possible contamination of the solution with other elements, e.g. with elements that would form unwanted compounds or precipitates in the prior art solution. Thus, the Shindo et al. process is held to create a prima facie case of obviousness of the presently claimed invention.

6. The examiner has carefully reviewed Applicant's arguments filed June 19, 2006 and agrees that the previously cited Gingerich patent does not disclose or suggest the invention as presently claimed. However, several of the instant claims remain rejected for reasons as detailed in the new grounds of rejection, supra.


Claims 3, 4 and 8 are allowable over the prior art of record, and claims 6 and 7 would be allowable provided that the objections to claims 6 and 7 noted in item no. 1 supra are corrected.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the new central facsimile number, (571)-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1700

GPW
August 28, 2006